UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,829	02/05/2004	Robert S. Cooper	114.0005	6010

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EXAMINER
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ART UNIT.	PAPER NUMBER
2609	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/772,829	COOPER ET AL.
	Examiner	Art Unit
	David Kovacek	2609

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-16</u> is/are rejected.

7)☒ Claim(s) <u>1</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 August 2004</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>07/06/2005</u>

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Drawings

1.   The drawings are objected to because **system 100** is referred to in the specification but not explicitly shown in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2.   The attempt to incorporate subject matter into this application by reference to "Methods and Apparatus for Context and Experience Sensitive Prompting in Voice Applications," assigned to a common assignee with the present invention is ineffective

because the proper US Patent Serial No. is not disclosed, and the appropriate location

of disclosure within the specification instead shows a blank space. The proper US

Patent Serial No. of this document should be fully disclosed in the specification.

3.	**Claim 1** is objected to because of the following informalities: the language of

claim 1 should read "...for the user <u>in</u> response to the voice inputs..." in the first

limitation after the preamble. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.	**Claims 1-16** are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent 6,560,576 hereinafter referred to as Cohen.

Regarding **claim 1**, Cohen discloses a voice recognition system comprising:

- A plurality of modules for receiving voice inputs from a user and performing services in response (Fig. 1, item 2; Fig. 2; Col. 4, lines 13-15; Col. 4, lines 31-32; Col. 4, lines 53-57); and

- A prompt selection module for selecting a prompt for presentation to a user (Col. 3, lines 26-31; Fig. 4; Fig. 5), the module being operative to identify an experience level of a user and select a prompt appropriate to the user's experience level (Col. 5, lines 48-55).

It is noted by the examiner that the broadest reasonable interpretation of "module" to one of ordinary skill in the art would include a "voice browser" as described in the context of Cohen.

Regarding **claim 2**, Cohen teaches all limitations of **claim 1** as applied above, and further discloses that the selection of a prompt is based upon the module and function in use (Col. 5, lines 48-55; Col. 5, line 63-Col. 6, line 10; Col. 6, lines 33-37).

Regarding **claim 3**, Cohen teaches all limitations of **claim 2** as applied above, and further discloses a module incorporating a prompt selection module to select prompts for that module (Col. 5, lines 63-67; Col. 6, lines 1-5; Col. 6, lines 7-10; Col. 6, lines 33-37).

It is noted by the examiner that Cohen only discloses a module in the context of the embodiment of a voice browser. It is additionally noted by the examiner that though Cohen does not explicitly state the existence of a prompt selection module, the

disclosure of prompt selection inherently requires some implementation to achieve this.
It is further noted that any such implementation would be considered synonymous with
the broadest reasonable interpretation of a "prompt selection module" by one of ordinary
skill in the art.

Regarding **claim 4**, Cohen teaches all limitations of **claim 3** as applied above,
and further discloses prompt selection for each module identifies the function for which
prompting is needed and selects from among prompts associated with that function
(Col. 5, lines 63-67; Col. 6, lines 1-5).

It is noted by the examiner that this is inherently required of any implementation
that is operable to determine a user's first use of a feature as disclosed by Cohen.

Regarding **claim 5**, Cohen teaches all limitations of **claim 4** as applied above,
and further discloses user information indicating the user's proficiency in using the
system (Col. 5, lines 49-55).

It is noted by the examiner that this limitation is inherently required of any system
that is operable to distinguish the user as being of "novice" or "expert" skill level as
disclosed by Cohen.

Regarding **claim 6**, Cohen teaches all limitations of **claim 5** as applied above,
and further discloses information indicating the user's proficiency includes information

indicating the user's proficiency with each function that is available to the user (Col. 5,

lines 49-55; Col. 8, lines 11-15).

It is noted by the examiner that this limitation is inherently required of any system

that is operable to distinguish the user as being of "novice" or "expert" skill level with

regard to a particular function as disclosed by Cohen.

Regarding **claim 7**, Cohen teaches all limitations of **claim 6** as applied above,

and further discloses information indicating a function usage tally for each function

indicating a number of times the user has successfully employed the function (Col. 5,

lines 63-67; Col. 6, lines 1-10; Col. 6, lines 33-37; Col. 8, lines 11-15; Col. 8, lines 22-

23; Col. 8, lines 53-64).

It is noted by the examiner that "dialog state", as determined in Cohen, is

understood to be an exchange of data between the user and an active module. This will

be the definition of "dialog state" applied throughout the remainder of this document.

It is further noted by the examiner that Cohen's disclosure of a "usage history

that tracks the dialog states of the user" (Col. 8, lines 12-13) would be understood by

one of ordinary skill in the art to include data regarding each of the functions used. One

of ordinary skill in the art would interpret a "function usage tally" to be a subset of this

data.

Regarding **claim 8**, Cohen teaches all limitations of **claim 7** as applied above,

and further discloses the prompt selection being used employs the function usage tally

for a function to determine a user experience category for the user with respect to that function (Col. 5, lines 50-51; Col. 5, lines 63-65; Col. 8, lines 22-23; Col. 8, lines 11-15).

It is noted by the examiner that this is explicitly disclosed in Cohen by regarding any user with a functional usage tally indicating less than one use of a given function to belong to the "novice" experience category.

Regarding **claim 9**, this claim is very similar to **claim 8** and is rejected for the same reasons.

Regarding **claim 10**, Cohen teaches all limitations of **claim 9** as applied above, and additionally discloses the prompt selection selects a prompt associated with the user experience category (Col. 5, lines 50-55).

Regarding **claim 11**, Cohen discloses a prompt selection comprising:

- identifying a module and function being employed when a need for user prompting arises (Col. 5, lines 50-55);

- identifying a user experience level for the function (Col. 5, lines 50-55; Col. 5, line 63-Col.6, line 11; Col. 6, lines 33-37); and

- selecting a prompt appropriate for the user experience level for the function (Col. 5, lines 50-55; Col. 5, line-Col. 6, line 11; Col. 6, lines 33-37).

It is noted by the examiner that the identification of the employed module and function is inherent in the disclosure of Cohen as illustrated for **claim 4** above. It is

further noted by the examiner that identifying a user experience level for a function is inherent in the disclosure of Cohen as illustrated for **claims 5** and **6** above.

Regarding **claim 12**, Cohen teaches all limitations of **claim 11** as applied above, and further discloses the step of identifying the user experience level is followed by a step of identifying the user as belonging to a particular experience category and the step of selecting a prompt includes selecting a prompt associated with the experience category to which the user belongs (Fig. 4; Fig. 5; Col. 5, lines 50-55; Col. 8, lines 65-66; Col. 9, lines 22-23).

It is noted by the examiner that this limitation is inherent in the disclosure of Cohen as illustrated for **claims 5, 6,** and **8** above.

Regarding **claim 13**, Cohen teaches all limitations of **claim 12** as applied above, and further discloses the identifying the user experience category for a function includes examining user information for that function (Col. 8, lines 11-15; Col. 8, lines 65-66; Col. 9, lines 22-23), the user experience information for the function includes a function usage tally indicating a number of times the function has been successfully invoked by the user (Col. 5, lines 49-51; Col. 8, lines 11-15; Col. 8, lines 52-53).

Regarding **claim 14**, Cohen teaches all limitations of **claim 13** as applied above, and further discloses that identifying the user experience category for a function includes assigning the user to an experience category associated with a range of

unction usage tally values within which the user's function usage tally for the function

falls (Col. 5, lines 49-55).

It is noted by the examiner that this limitation is inherent to the disclosure of

Cohen as illustrated for **claims 8** and **9** above.

Regarding **claim 15**, Cohen teaches all limitations of **claim 14** as applied above,

and further discloses updating the user information for each function whenever the user

successfully invokes the function (Col. 8, lines 11-15; Col. 8, lines 52-53).

It is noted by the examiner that one of ordinary skill of the art would consider

"usage history" as disclosed by Cohen to be updated upon any changes in relevant

data, including the successful usage of a function by the user.

Regarding **claim 16**, this claim is very similar to **claim 15** and is rejected for the

same reasons.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

5.   **Claims 1** and **11-14** are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over **claims 1** and **10-13** of

copending Application No. 2005/0177373. Although the conflicting claims are not

identical, they are not patentably distinct from each other because **claims 1** and **11-14**

of the current application encompass or are encompassed by one or more of **claims 1**

and **10-13** of copending Application No. 2005/0177374. An example of the comparison

between the claim language of the two applications is shown below for **claim 1**:

Language in 2005/0177374	Language in Current Application	Comparison
1. A voice recognition system comprising: a plurality of modules for receiving voice inputs from a user and performing services based on the user response to the voice inputs;	1. A voice recognition system comprising: a plurality of modules for receiving voice inputs from a user and performing services for the user response to the voice inputs;	These parts of each claim are identical.
and a help application for selecting a help prompt for presentation to a user upon receipt of an unrecognized or erroneous input,	and a prompt selection module for selecting a prompt for presentation to a user,	Here, a "help application for selecting a help prompt" could be considered a subset of a "prompt selection module."
the help application being operative to identify an	the prompt selection module being operative to identify	Considering the possible synonymous meaning as noted

experience level of a user and select a help prompt appropriate to the user's experience level.	an experience level of a user and select a prompt appropriate to the user's experience level.	above, the only difference between the language here is the specification of a "help prompt" in the current application as opposed to a "prompt" in the other application.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Porter et al. (US Patent 6,154,527) teaches an interactive voice response system.

- Norton et al. (US Patent 6,510,411) teaches a dialog management system.

- Pickering (US Patent 6,944,592) teaches a voice response system that generates prompts based upon user voice input.

- Caspari (US Patent Application 2002/0169618) teaches method of generating help prompts in a speech dialog system.

- Ehlen (US Patent Application 2004/0006480) teaches a system and method of problematic input for multi-modal dialog systems.

- Fellenstein et al. (US Patent Application 2005/0069095) teaches a method for searching in a voicemail system.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to David Kovacek whose telephone number is (571) 270-
3135. The examiner can normally be reached on M-F 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Alexander Eisen can be reached on (571) 272-7687. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Eisen
SPE
Art Unit 2609

DMK 07/06/2007